



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Holland, et al.

Serial No.: 09/758,067

Confirmation No.: 7121

Filed: January 10, 2001

For: NONABRASIVE MEDIA WITH ACCELERATED
CHEMISTRY

Group Art Unit: 1763

Examiner: Anna M. Crowell

Atty. Dkt. No.: 12350.0008.NPUS00

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RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
Washington, D.C. 20231

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In response to the Office Action mailed on August 28, 2002, Applicants request the following:

TRAVERSAL OF RESTRICTION REQUIREMENT:

Applicants traverse the restriction requirement on the grounds that, in light of the preliminary amendment filed herewith, the restriction requirement has been rendered moot. The Examiner pointed out that two inventions are distinct if either or both of the following can be shown: 1) the process as claimed can be used to make other and materially different products; or 2) the product as claimed can be made by another and materially different process. MPEP §

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806.05(f). Given the amendments to claims 1 and 8, and the addition of new claims 9-21, neither of the above two conditions are applicable to the currently pending claims.

In response to the Examiner's argument that the process can be used to finish a non-metal article, Applicants respectfully point out to the examiner that what is claimed is a process to finish a metal article, not a nonmetal article. Similarly, the metal article claims 8 and 12-21 claim a metal article finished by the process having substantially the same steps of claims 1-7 and 9-11. Thus, the process claims 1-7 and 9-11 can only be used to finish a metal article, while the metal article claims 8 and 12-21 can only be made by the process claims 1-7 and 9-11. Thus, the Examiner's restriction requirement is unfounded.

There are 2 criteria for a proper restriction requirement: 1) the inventions must be independent or distinct as claimed; and 2) there must be a serious burden on the Examiner. MPEP § 803. In this case, the process and article claims are dependent and not distinct. "Independent" means that there is no disclosed relationship between the two or more subjects disclosed; that is, they are unconnected in design, operation, or effect. MPEP § 802.01. In this case, the process and metal article claims are dependent (i.e. not independent), in that the process only makes the metal article, and the metal article is only made by the process.

"Distinct" means two or more subjects are related, such as process and product made, but are capable of separate manufacture, use or sale as claimed and are patentable over each other. MPEP § 802.01. In this case, the process and metal article claims are not distinct. First, they are not capable of separate manufacture, use, or sale as claimed. As pointed out above, the process only makes the metal article, and the metal article is only made by the process. The two are inseparable; you cannot use the process without making the metal article. Conversely, you cannot make the metal article without using the process. Thus, the process and metal article claims are not distinct. Finally, Applicants submit that the metal article claims would not be independently patentable over the process claims, in that if the process was known in the art, the metal articles would also be known in the art and would thus anticipate any patent on the metal articles alone. Thus, the final requirement of "distinct" is not met, as the metal article claims would not be patentable over the process claims.

Applicants respectfully requests that if the Examiner does not withdraw the restriction requirement, that the Examiner document a viable alternative process or product, as required by MPEP 806.05(f).

Because the process and article claims are not independent and not distinct, burden on the Examiner need not be addressed due to the conjunctive nature of the two elements for a restriction requirement. However, it is respectfully submitted that during the searching of the prior art for the limitations recited in the claims of the provisionally elected Group I, the Examiner will necessarily to search the classes that include Group II, as the metal articles of group II can only be made by the process of Group I. Therefore, the Examiner will not be subjected to multiple searches and thus the current situation does not constitute an undue burden for the Examiner. In view of the above arguments, Applicant requests that the restriction requirement be reconsidered and withdrawn, and all the claims be examined together on the merits.

PROVISIONAL ELECTION OF GROUP I:

Applicant requests that the Examiner conduct the examination of the above referenced application based on Group I.

Applicant requests for any extension of time that may be deemed necessary to further the prosecution of this application.

Applicant's representative authorizes the Commissioner to charge any additional fees which may be required, or credit any overpayment, to Deposit Account No. 01-2508, referencing Order No. 12350.0008.NPUS00.

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In order to facilitate the resolution of any issues or questions presented by this paper, Applicant respectfully requests that the Examiner directly contact the undersigned by phone to further the discussion.

In order to promote the prosecution of this application, the Examiner is authorized to contact the undersigned by electronic mail. Please address all e-mail to:
steinheiderm@howrey.com

Respectfully submitted,



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Date: 9/19/02